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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/780,113
Filing Date: February 17, 2004
Appellant(s): MEESSEN, HANS

Christopher B. Jacobs
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/15/2006 appealing from the Office action mailed 6/16/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,356,363	Koppe et al.	10-1994
6,756,096	Harding	1-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-4, 7-8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (5749821) in view of Kopp et al. (5356363).

Simmons discloses a dunnage conversion system and method for converting multiple plies of sheet material (106, 108, 110, fig. 7) into a relatively less dense, three-dimensional dunnage product, the system comprising a converter (34, fig. 2) including a conversion assembly (26, fig. 2) that is driven by a motor (36, fig. 2) to advance multiple plies of sheet material through the converter for conversion of the multiple plies of sheet material into a relatively less dense, three-dimensional dunnage product, where the multiple plies of sheet stock material are fed to the conversion assembly along respective in feed paths, a controller (32, fig. 2) that controls operation of the motor and an end-of-web detector (118, fig. 8) located upstream of the conversion assembly for detecting the presence or absence of the ply and providing an output to the controller indicative thereof (see col. 6, lines 29-52).

Simmons, as mentioned above, discloses all the claimed limitations, except for the end-of-web detector including plural sensors respectively associated with the separate in-feed paths for detecting the presence or absence of the respective ply. However, Kopp et al. teach the end-of-web detector including plural sensors (7, 67, fig.

1) respectively associated with the separate in-feed paths (of three webs 2, fig. 1) for detecting the presence or absence of the respective ply (see col. 2, lines 8-11; col. 3, lines 20-24; col. 4, lines 55-64). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the end-of-web detector including plural sensors respectively associated with the separate in-feed paths as taught by Simmons in the dunnage conversion system and method for converting multiple plies of sheet material into three-dimensional dunnage product of Simmons for detecting the presence or absence of the respective ply and signal generated by the sensor may be used by the controller to stop the feed motor.

Regarding claims 2-4, Simmons discloses that the sensor includes a transmitter for transmitting an electromagnetic beam and a receiver for receiving the electromagnetic beam (see col. 6, lines 35-46).

Regarding claims 7 and 12-13, Simmons discloses separating rollers (100, 102, fig. 7) interposed between the in-feed paths of the sheet stock material plies for separating the plies.

Regarding claim 14, the conversion system of Simmons as modified by Kopp, as mentioned above, teaches the means for converting or equivalent three of, means for detecting the presence of each ply or equivalent three of and means for controlling the means for converting or equivalent three of.

Claims 5-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons and Kopp et al. as applied to claims 1-4 and 8 above, and further in view of Harding (6756096).

Simmons' dunnage conversion system and method for converting multiple plies of sheet material into a relatively less dense, three-dimensional dunnage product modified by Kopp et al. meets all the limitations of claims 5 and 9, except for a splicing surface against which the trailing ends of the plies of a spent supply of stock material can be Joined to the leading ends of the plies of a new supply of stock material. However, Harding teaches the splicing surface against which the trailing ends of the plies of a spent supply of stock material can be Joined to the leading ends of the plies of a new supply of stock material (see figs. 6-11) to provide an improved splicing method and supply of sheet stock material which simplifies splicing a succeeding supply of stock material to an almost spent supply of stock material (see col. 2, lines 6-10). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the splicing surface as taught by Harding in the modified system and method for converting multiple plies of sheet material into a relatively less dense, three-dimensional dunnage product of Simmons to provide an improved splicing method and supply of sheet stock material which simplifies splicing a succeeding supply of stock material to an almost spent supply of stock material.

Regarding claims 6 and 10-11, Simmons discloses separating rollers (100, 102, fig. 7) interposed between the in-feed paths of the sheet stock material plies for separating the plies.

(10) Response to Argument

Appellant argues on pages 15-22 that the rejection of claims 1-14 under U.S.C. 103(a) was improper for failure to state a prima facie case of obviousness for want of

any teaching, suggestion or motivation to combine Simmons, Kopp or Harding in a manner that would yield the claimed subject matter. And further, Appellant argues that in a proper prima facie case of obviousness, every element of the claims must be taught or suggested by the applied references, and there must be some teaching, suggestion or motivation to combine the teachings of the references in the proposed manner.

Examiner is aware that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). *See also* MPEP 2143.01.

In this instance, the Examiner recognizes that references cannot be arbitrarily combined and there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining reference is what the combination of disclosures take as a whole would suggest to one of the ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this instance, Simmons discloses the invention as claimed including an end of web detector (118) for detecting the presence or absence of the ply and providing an output to the controller (32) indicative thereof (to cease the motor, 36). The teaching of Kopp was chosen to show Appellant that providing sensor for each one of the multiple plies of sheet material of

Simmons to detect the shortest web of the multiple webs. Examiner did not rely on the Kopp reference to show that the control of the motor for the conversion assembly to which multiple plies of sheet material are being fed based on detecting the presence or absence of each ply (as argued by the Appellant on page 19).

Appellant's arguments regarding motivation (pages 19-22), note that, Appellant provided the problems and shortcomings of Simmons's single sensor to detect the end of the plural plies (see page 2, lines 23-32 of specification). Kopp reference provides the solution to the problems and shortcomings of the Simmons' reference by providing plural sensors respectively associated with the separate infeed path for detecting the presence or absence of the respective ply. And therefore the combination of disclosures of Simmons and Kopp take, as a whole would suggest to one of the ordinary skill in the art to combine the references of Simmons and Kopp. Since there is only one motor in the Simmons reference, when any one of the plurality of sensors detect the end of the respective ply it will stop the only feed motor. The 103(a) rejection of claim 1 should be affirmed.

Appellant's arguments regarding claim 8, note that, as discussed above, Simmons discloses the invention as claimed including: the steps of operating the motor (36) of a converter (34) to drive a conversion assembly (26) that advances multiple plies of sheet material (106, 108, 110) through the converter for conversion of the multiple plies of sheet material into a relatively less dense dunnage product, feeding multiple plies of sheet stock material to the conversion assembly along respective infeed paths, using a sensor (118) to detect the presence or absence of the ply, and ceasing

operation of the motor in response to a signal from the sensor (col. 6, lines 29-52). The teaching of Kopp was chosen to show Appellant that providing sensor for each one of the multiple plies of sheet material of Simmons to detect the shortest web of the multiple webs. Examiner did not rely on the Kopp reference to show that the bag-making assemblies arranged in parallel, as argued on page 24, or each of Kopp's sensors only control the brake arms associated with that particular sensor and bag-making assembly, as argued on page 25. Kopp reference provides the solution to the problems and shortcomings of the Simmons' reference by providing plural sensors respectively associated with the separate infeed path for detecting the presence or absence of the respective ply. Since there is only one motor in the Simmons reference, when any one of the plurality of sensors as taught by Kopp reference, detect the end of the respective ply, it will stop the only feed motor. The 103(a) rejection of claim 8 should be affirmed.

For the same reasons specified for claims 1 and 8, above, the 103(a) rejection of claim 14 should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Hemant M. Desai.
Hemant Desai

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